

**REMARKS**

Applicants acknowledge receipt of the Office Action mailed February 4, 2008.

In the Office Action, the Examiner rejected claims 75 and 90-101 under 35 U.S.C. § 102(b) as being anticipated by *Richards et al.* (U.S. Patent No. 6,296,809); and rejected claims 102-113 under 35 U.S.C. § 103(a) as being unpatentable over *Richards* in view of *Ammann et al.* (U.S. Patent Pub. No. 2005/0233370).

By this Amendment, Applicants amend claim 102. Claims 1-47, 75, and 90-113 remain pending, with claims 1-47 withdrawn from consideration. Of the claims under examination, claims 75 and 102 are independent.

Applicants traverse the rejections above and respectfully request reconsideration for at least the reasons that follow.

**I. 35 U.S.C. § 102(b) REJECTION**

Applicants traverse the rejection of claims 75 and 90-101 under 35 U.S.C. § 102(b) as being anticipated by *Richards*. Applicants respectfully submit that independent claim 75 distinguishes over *Richards* at least for the reasons described below.

In order to properly establish that *Richards* anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

*Richards* appears to disclose an apparatus and method for automatically staining or treating multiple tissue samples mounted on microscope slides. Individualized slide temperature control is accomplished by a heating system 48, which includes thermal platforms radially mounted to a carousel for heating the slides and sensing the temperature of each. (*Richards*, Abstract).

*Richards*, however, does not disclose an active temperature regulation element to which at least one **sample** is responsive, wherein the active temperature regulation element regulates the temperature of the at least one sample **at a set point** and to **within a tolerance** specified by a **protocol**, as required by claim 75.

Rather, the slide heating system 48 of *Richards* regulates the temperature of the slides and not a sample. As disclosed in col. 6, lines 58-62 of *Richards*, “[i]f, during a run, the slide temperature is determined to be below the programmed lower limit, the thermal platform heats the slide. Likewise, if the slide temperature is found to be above the upper limit, heating is stopped.” Accordingly, the heating system 48 does not monitor how a sample is responsive to heat or changes in the atmosphere. Furthermore, the heating system 48 does not bring the temperature of a sample to a set point and within a tolerance specified by a protocol.

As disclosed in Applicants’ specification on page 11, lines 26-30, “[t]he sample processing system may further have the ability to maintain and regulate the internal temperature of the system, including maintaining and regulating the temperature of samples..., to specified temperatures, and even within temperature tolerances of certain sample protocols. Controlling temperature can avoid a need to alter protocols for seasonal or other non-optimal temperature variations.”

Accordingly, with respect to independent claim 75, *Richards* fails to teach

Applicants' claimed combination, including, *inter alia*:

an active temperature regulation element to which...at least one sample is responsive, wherein said active temperature regulation element regulates [a] temperature of said at least one sample at a set point and to within a tolerance specified by [a] protocol (emphases added).

Since *Richards* fails to disclose each and every element of independent claim 75, *Richards* fails to anticipate claim 75, and claims 90-101, that depend from claim 75.

Therefore, Applicants respectfully request that this rejection be withdrawn.

## **II. 35 U.S.C. § 103(a) REJECTION**

Claims 102-113 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Richards* in view of *Ammann*. Applicants respectfully disagree with the Examiner's arguments and conclusions and submit that independent claim 102 distinguishes over *Richards* and *Ammann* at least for the reasons described below. The deficiencies of *Richards* are discussed above.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *Id.* "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P. § 2145. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. M.P.E.P. § 2143.01(III),

internal citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

As discussed above, *Richards* appears to disclose an apparatus and method for automatically staining or treating multiple tissue samples mounted on microscope slides. Individualized slide temperature control is accomplished by a heating system 48, which includes thermal platforms radially mounted to a carousel, for heating the slides and sensing the temperature of each. (*Richards*, Abstract).

As admitted by the Examiner, “Richards...does not expressly disclose that reagent temperature control elements are provided for regulating the temperature of reagents before they are applied to the sample.” (*Office Action*, p. 5, ll. 5-7). Furthermore, as reiterated above, *Richards* also fails to disclose or suggest “a sample temperature control element to which...at least one **sample** is responsive, wherein said sample temperature control element regulates [a] temperature of said at least one

sample **at a set point** and to **within a tolerance** specified by [a] **protocol**,” as recited in claim 102.

In order to cure the deficiencies of *Richards*, the Examiner relies on *Ammann* and alleges “Ammann teaches that thermoelectric modules and fan units provide the desired cooling capacity, and are capable of regulating the temperature of a plurality of reagents maintained in a plurality of containers.” (*Office Action*, p. 5, ll. 13-15). Such teaching, even if disclosed in *Ammann*, which Applicants do not necessarily concede, fails to teach or suggest, “a sample temperature control element to which...at least one sample is responsive, wherein said sample temperature control element regulates [a] temperature of said at least one sample at a set point and to within a tolerance specified by [a] protocol,” as recited in independent claim 102. Thus, *Ammann* also fails to overcome the above noted shortcomings of *Richards*.

As explained above, the elements of independent claim 102 are neither taught nor suggested by the cited references. Consequently, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Accordingly, no reason has been clearly articulated as to why the claims would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for independent claim 102, and claims 103-113, which depend from claim 102. Claims 102-113 are therefore patentable over *Richards* and *Ammann*. Applicants request that the rejection of claims 102-113 under 35 U.S.C. § 103(a) be withdrawn.

### III. CONCLUSION

Applicants respectfully submit that claims 75 and 90-113 are in condition for allowance.

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

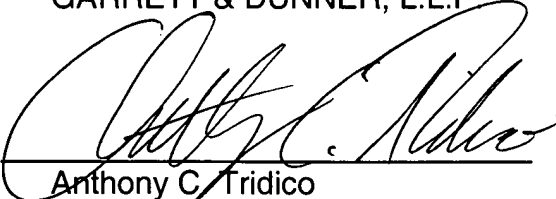
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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